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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,990	03/16/2004	Donald L. Clason	3270	3925
7590 04/13/2007 THE LUBRIZOL CORPORATION Patent Administrator - Mail Drop 022B 29400 Lakeland Boulevard Wickliffe, OH 44092-2298			EXAMINER GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1714	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/13/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/802,990

Applicant(s)

CLASON, DONALD L.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-19, 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-19, 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. While the same references used to reject claim 18 in the office action mailed 10/26/06 are used in the rejections set forth below, new arguments have been advanced.

Claim Rejections - 35 USC § 103

2. Claims 18-19, 21-28, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer (U.S. Pat. No. 3,708,522) in view of Stewart (U.S. Pat. No. 4,244,279).

The discussions of LeSuer in paragraph 6 of the office action mailed 10/26/06 and LeSuer in view of Stewart in paragraph 11 of the office action mailed 10/26/06 are incorporated here by reference. LeSuer discloses lubricating compositions meeting the compositional limitations of claims 18-19, 21-28, and 30-31, and further discloses in column 14 lines 4-8 that hydraulic fluids can also benefit from the additives of the reference, in particular the nitrogen-free dispersant. Therefore, it would have been obvious to one of ordinary skill in the art to use a lubricant meeting the limitations of claim 18 as the lubricant in the hydrostatic transmission of Stewart.

3. Claims 18-19, 21-31, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart, as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Stewart.

The discussions of LeSuer in view of Stewart in paragraph 2 above and LeSuer in view of Emert in paragraph 10 of the office action mailed 10/26/06 are incorporated here by reference. The difference between LeSuer in view of Stewart and the currently presented claims is that LeSuer and Stewart do not disclose the specific additives and concentrations recited in claims 29 and 33-35.

The use of the polyacrylates and polymethacrylate viscosity modifiers and sulfurised phenate detergents of Emert in the composition of LeSuer and Stewart meets the limitations of claims 29 and 33, as discussed in the prior office action (new claims 29 and 33 are analogous to original claims 10 and 14). Emert additionally teaches that the composition can contain an antioxidant which is a hindered phenol (column 70 lines 61-62, examples in columns 70-71) or diphenylamine (various examples in column 75 lines 10-34). In the table in column 81 lines 19-32, LeSuer teaches that a lubricating composition contains 0.01 to 10% by weight of the dispersant, 0.0001 to 5% by weight of the primary metal dihydrocarbyl dithiophosphate (antiwear agent, column 68 lines 37-41), 1 to 12% by weight of a viscosity modifier, 0.01 to 5% by weight of an antioxidant, and 0.01 to 6% by weight of a detergent, all falling within or overlapping the ranges recited in claim 35. Emert additionally teaches in column 70 lines 6-7 that primary metal dihydrocarbyl dithiophosphates impart thermal stability. The use of the additive and concentrations of Emert in the composition of LeSuer and Stewart meets the limitations of 18-19, 21-31, and 33-35.

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It would have been obvious to one of ordinary skill in the art to use the additives and concentrations of Emert in the composition of LeSuer and Stewart in order to gain the advantages taught by Emert in columns 60-81.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart as applied to claims 18-19, 21-28, and 30-31 above, and further in view of Byford (U.S. Pat. No. 3,697,427).

The discussion of LeSuer in view of Stewart in paragraph 2 above is incorporated here by reference. LeSuer in view of Stewart discloses a method of lubricating meeting the limitations of claim 31, and LeSuer further discloses that the lubricant can contain a metal deactivator, but not the specific metal deactivator recited in claim 32.

Byford, in column 1 lines 25-28, discloses a lubricating composition. In column 2 lines 6-7 and 11-34, Byford teaches that a copper passivator, which is a metal deactivator, is a useful additive for lubricant compositions. In column 2 lines 31-34 Byford teaches that substituted benzotriazoles such as methylbenzotriazole are suitable metal deactivators.

It would have been obvious to one of ordinary skill in the art to use the substituted benzotriazoles of Byford as the metal deactivator in the lubricating method of LeSuer and Stewart, in order to prevent corrosion of metal surfaces, as taught in column 2 lines 15-22 of Byford.

Response to Arguments

5. Applicant's arguments with respect to claims 18-19 have been considered but are moot in view of the new ground(s) of rejection. However, it is noted that LeSuer teaches the effectiveness of certain additive compositions in hydraulic fluids, regardless of whether LeSuer teaches the fluids themselves. Claims 21-35 are new.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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